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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NAI1P449/01.143.01

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on May 23, 2006

Signature

Typed or printed name Erica L. Farlow

Application Number

09/976,009

Filed

10/15/2001

First Named Inventor

Neil John Hursey et al.

Art Unit

2136

Examiner

Colin, C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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REMARKS

The Examiner has rejected Claims 1-3, 5-12, 14-21, 23-30, 32-39, 41-48 and 50-54 under 35 U.S.C. 103(a) as being unpatentable over Lahti et al. (U.S. Patent Application No. 2002/0042886) in view of Hansson (WO 98/38820). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has relied on paragraphs [0019] and [0023] in Lahti along with page 6, lines 1-5 in Hansson to make a prior art showing of applicant's claimed technique "wherein said mobile data processing device registers with a base station of said wireless telephony network when said link is established such that said base station and said wireless telephony network are notified of a telephone number of said mobile data processing device for use in sending said malware definition updating data to said mobile data processing device."

First, applicant respectfully asserts that neither Lahti nor Hansson disclose a "mobile data processing device [that] registers with a base station of said wireless telephony network when said link is established," as claimed by applicant (emphasis added). In particular, Lahti only generally teaches that "a record of all subscribers to the anti-virus server [is maintained] in a database" (paragraph [0023]), but not that a "mobile data processing device registers with a base station...when said link is established," as applicant claims. In addition, the entire Hansson reference, and in particular the excerpt in Hansson relied on by the Examiner, fails to even suggest any sort of registration, and especially not in the specific manner claimed by applicant.

Second, applicant notes that the Examiner has relied on Hansson's disclosure of an "update server processor 100 [that] downloads the software by placing a call to the cellular phone and performing...[a] data transfer to the cellular telephone 110." Applicant respectfully asserts that simply utilizing a phone number to transfer a download does not meet applicant's specific claim language, namely that a "mobile data processing device registers with a base station of said wireless telephony network when

said link is established such that said base station and said wireless telephony network are notified of a telephone number of said mobile data processing device for use in sending said malware definition updating data to said mobile data processing device” (emphasis added), in the context claimed.

In fact, applicant emphasizes that Hansson actually *teaches away* from registering such that notification of a telephone number is made, in the manner claimed by applicant, since Hansson discloses that “[i]n response to the cellular telephone subscriber’s acceptance of the update, the cellular telephone 110 transmits a SMS message to the update server processor 100, wherein the message contains an acceptance code and the telephone number of the cellular telephone 110” (see page 5, lines 15-18-emphasis added).

In the Advisory mailed 04/11/2006, the Examiner, in response, argued that “[a]pplicant concedes that Lahti teaches a register that contains record of all the subscribers to the anti-virus service, therefore it is inherent or obvious to one of ordinary skill in the art that there is teaching and/or suggestion of registration of the subscribers in order for the center to have the records of the subscribers that subscribe to the service.” Applicant respectfully disagrees with the Examiner’s inherency/obviousness argument. Whether or not the above statement by the Examiner is correct or not, the Examiner has still not taken into consideration the full weight of applicant’s claims. Specifically, Lahti only suggests “registered subscribers” (emphasis added). Merely maintaining a record of registered subscribers simply does not meet a technique “wherein said **mobile data processing device** registers **with a base station** of said wireless telephony network **when said link is established**...” (emphasis added), as claimed by applicant.

Still with respect to each of the independent claims, the Examiner has relied on paragraphs [0022]-[0027] in Lahti to make a prior art showing of applicant’s claimed technique “wherein said malware definition updating data is provided in a malware definition updating file, where said file is generated by one of automatically, semi-automatically, and manually upon an analysis of newly discovered malware and where

said file includes a detection fingerprint, and at least one of a removal action and a disinfection action to be taken in response to a detection of said newly discovered malware.”

Applicant respectfully asserts that such excerpt from Lahti only discloses an “SMS request...containing signatures for viruses discovered and analysed since the previous update...which causes the new signature(s) to be incorporated into the anti-virus database for future use.” Thus, Lahti teaches that the message only contains the updated virus signatures, and not that the “file includes... at least one of a removal action and a disinfection action to be taken in response to a detection of said newly discovered malware,” as claimed by applicant. To further emphasize such distinction, applicant points out paragraph [0027] in Lahti which states that “the user is warned 30 and given the opportunity to delete or clean that file.” Clearly, a user that must decide whether to delete or clean a file does not suggest that a malware definition updating file “includes at least one of a removal action and a disinfection action to be taken in response to a detection of said newly discovered malware” (emphasis added), as applicant claims.

In the Advisory mailed 04/11/2006, the Examiner, in response, argued that “[i]n response to Applicant’s argument that Lahti only discloses messages that contain updates and not files, Examiner asserts that Lahti discloses and suggests several ways of obtaining updates...” However, applicant respectfully asserts that the cited excerpts from Lahti fail to even suggest a technique “... where said file includes a detection fingerprint, and at least one of a removal action and a disinfection action to be taken in response to a detection of said newly discovered malware” (emphasis added), as claimed. Lahti’s teaching that “the user is warned 30 and given the opportunity to delete or clean that file” in no way even suggests that the “definition updating file” includes “at least one of a removal action and a disinfection action” (emphasis added), as claimed by applicant. Only applicant teaches and claims an updating file including such specifically claimed action(s).

Furthermore, with respect to each of the independent claims, the Examiner has failed to specifically address applicant's claimed technique "wherein said mobile data processing device is identified by a database of subscribers to an update service associated with said malware scanner, where said database includes said telephone number of said mobile data processing device to which said malware definition updating data is to be sent and a type of said mobile data processing device such that only malware definition updating data that is appropriate to said type of said mobile data processing device is sent to said mobile data processing device" (emphasis added).

Applicant notes, however, that in Lahti "an SMS message [is sent] to the server 12 from a device 1...containing details of which virus signatures are currently stored in the device's signature database" such that "the anti-virus server 12 needs only to issue an SMS request...containing virus signatures not currently on the signature database of the mobile device 1." Thus, Lahti only teaches determining appropriate updated signatures based on signatures already located on the device, and not that a "database includes a type of said mobile data processing device such that only malware definition updating data that is appropriate to said type of said mobile data processing device is sent to said mobile data processing device," as applicant claims (emphasis added).

In the Advisory mailed 04/11/2006, the Examiner, in response, argued "[i]n response to Applicant's argument that Lahti does not disclose a database that includes a type of mobile device, this limitation is already addressed by Examiner as cited in paragraphs 23-26, the server generates a corresponding update upon request from the subscriber." However, Lahti's disclosure that "[u]pon receipt of a request, the SMS centre 5 generates a corresponding SMS message and send this to the destination mobile device..." simply fails to meet a technique "where said database includes said telephone number of said mobile data processing device to which said malware definition updating data is to be sent and a type of said mobile data processing device such that only malware definition updating data that is appropriate to said type of said mobile data processing device is sent to said mobile data processing device" (emphasis added), as claimed by applicant. There simply is no disclosure in the excerpts from Lahti relied

upon by the Examiner for a technique where “only malware definition updating data that is appropriate to said type of said mobile data processing device is sent to said mobile data processing device” (emphasis added), as claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.